Attorney's Docket No.: 17072-002001
Client's Ref. No.: 0271

OFFICIAL COMMUNICATION FACSIMILE:

OFFICIAL FAX NO: (571) 273-8300

RECEIVED
CENTRAL FAX CENTER
MAY 11 2006

Number of pages including this page 7 pages

Applicant	: Robert Thomas Hudak	Art Unit	: 1641
Serial No.	: 09/915,494	Examiner	: Gary W. Counts
Filed	: July 25, 2001	Conf. No.	: 6752

Title : Specimen Collection Container

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attached to this facsimile communication cover sheet is REPLY BRIEF, faxed this 11th day of May, 2006, to the United States Patent and Trademark Office.

Respectfully submitted,

Date: May 11, 2006

Fred C. Hernandez
Reg. No. 41,832

PTO Customer No.: 20985
Fish & Richardson P.C.
12390 El Camino Real
San Diego, California 92130
Telephone: (858) 678-5625
Fax: (202) 626-7796
Email: fhernandez@fr.com

10630341.doc

NOTE: This facsimile is intended for the addressee only and may contain privileged or confidential information. If you have received this facsimile in error, please immediately call us collect at (858) 678-5070 to arrange for its return. Thank you.

Attorney's Docket No.: 17072-002001 / 0271

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Robert Thomas Hudak	Art Unit:	1641
Serial No:	09/915,494	Examiner:	Counts, Gary W.
Filing Date:	July 25, 2001	Conf. No.:	6752

RECEIVED
CENTRAL FAX CENTER
MAY 11 2006

Title: SPECIMEN COLLECTION CONTAINER

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

This Reply Brief is filed in response to the Examiner's Answer mailed May 3, 2006.

CERTIFICATE OF TRANSMISSION BY FACSIMILE

I hereby certify that this correspondence is being transmitted by facsimile to the Patent and Trademark Office on the date indicated below.

May 11, 2006
Date of Transmission

Cecilia Tobin
Signature

Cecilia Tobin
Typed or Printed Name of Person Signing Certificate

Index of Authorities

PAGE 3/8 * RCVD AT 5/11/2006 7:04:59 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/11 * DNIS:2738300 * CSID:1 858 678 5099 * DURATION (mm-ss):02-26

Status of Claims

Claims 74-102 are pending in the present case and are on appeal.

PAGE 4/8 * RCVD AT 5/11/2006 7:04:59 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/11 * DNIS:2738300 * CSID:1 858 678 5099 * DURATION (mm-ss):02-26

Grounds of Rejection to be Reviewed on Appeal

Whether claims 74-75, 79, 85-92, and 94-102 are properly rejected as being anticipated under 35 U.S.C. 102(e) by Cui et al. (US 6,576,193).

Whether claims 76 is properly rejected as unpatentable under 35 U.S.C. 103(a) over Cui et al. in view of Nelson et al. (US 5,115,934).

Whether claims 77-78 are properly rejected under 35 U.S.C. 103(a) as being unpatentable over Cui et al. in view of Alley (US 2002/00446614).

Whether claims 80 and 84 are properly rejected under 35 U.S.C. 103(a) as being unpatentable over Cui in view of Mitsumaki et al. (US 4,680,270) and Pampinella (US 2002/0023482).

Whether claims 81-83 are properly rejected under 35 U.S.C. 103(a) as being unpatentable over Cui et al. in view of Carter et al. (US 4,909,933).

Whether claim 93 is properly rejected under 35 U.S.C. 103(a) as being unpatentable over Cui et al. in view of Ehrenkranz (US 4,769,215).

PAGE 5/8 * RCVD AT 5/11/2006 7:04:59 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/11 * DNIS:2738300 * CSID:1 858 678 5099 * DURATION (mm-ss):02-26

Argument

The Examiner's Answer alleges that the limitation in the claim of "the valve being inoperable after a first actuation" can be simply ignored because it is "a recitation of intended use of the valve"[1] and that Cui discloses the same device and valve as recited in the remaining limitations. Cui does not disclose or suggest a specimen collection device having a valve that is inoperable after a first actuation, as claimed. The limitation at issue is not a mere statement of purpose or use as contended in the rejection. Instead it is a genuine limitation of the claim and a characteristic of the claimed device, and must be given patentable weight.

Again the Examiner has cited no authority for the proposition that some claim limitations can be simply ignored. This proposition is directly contrary to numerous statements of the Federal Circuit and U.S. Supreme Court, which clearly establish that every limitation of a claim is material to patentability. A representative example of cases includes *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17; 41 USPQ2d 1865 (1997), *on remand*, 114 F.3d 1161; 43 USPQ2d 1152 (Fed. Cir. 1997) (*Order Per Curiam*) ("Each element contained in a patent claim is deemed material to defining the scope of the patented invention..."); *Pennwalt Corp. v. Durand-Wayland, Inc.* 833 F.2d 931; 4 USPQ2d 1737 (Fed. Cir. 1987) (*in banc*), *cert. denied*, 485 U.S. 961 (1988) ("[I]f...even a single function required by a claim or an equivalent function is not performed by [an accused device], ... [a] finding of no infringement must be upheld"); *Glaxo, Inc. v. Novopharm, Ltd.*, 110 F.3d 1562; 42 USPQ2d 1257 (Fed. Cir. 1997) ("It is elementary patent law that all limitations are material"); *TechSearch, L.L.C. v. Intel Corp.* 286 F.3d 1360; 62 USPQ2d 1449 (Fed. Cir. 2002) ("[S]pecific claim limitations cannot be ignored as insignificant or immaterial in determining infringement."); *Oak Technology, Inc. v. U.S. Int'l Trade Comm'n*, 248 F.3d 1316; 58 USPQ2d 1545 (Fed. Cir. 2001) ("[T]o construe the claims in the manner suggested [by the patentee] would read an express limitation out of the claims. This we will not do because [c]ourts can neither broaden nor narrow claims to give the patentee something different [from] what he has set forth").

[1] Examiner's Answer, p. 9, last line – p. 10, 5.

PAGE 6/8 * RCVD AT 5/11/2006 7:04:59 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/11 * DNIS:2738300 * CSID:1 858 678 5099 * DURATION (mm-ss):02-26

In view of the long line of Federal Circuit and U.S. Supreme Court case law cited above, relief from the rejection is respectfully petitioned, and that the claims be passed to allowance.

PAGE 7/8 * RCVD AT 5/11/2006 7:04:59 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/11 * DNIS:2738300 * CSID:1 858 678 5099 * DURATION (mm-ss):02-26

Closing

The U.S. Patent & Trademark Office is authorized to debit deposit account #06-1050 for any charges related to extension fees or other fees that may be due with this filing and that are not otherwise included herein.

Applicants respectfully submit that the pending claims are in condition for allowance and respectfully request that all rejections be reversed.

Respectfully submitted,

Date: May 11, 2006

Fred C. Hernandez
Reg. No. 41,832

USPTO Customer No.: 20985
Fish & Richardson, P.C.
12390 El Camino Real
San Diego, California 92130
Tel: (858) 678-5625
Fax: (202) 626-7796
Email: fhernandez@fr.com

10630321.doc

PAGE 8/8 * RCVD AT 5/11/2006 7:04:59 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/11 * DNIS:2738300 * CSID:1 858 678 5099 * DURATION (mm-ss):02-26